

# Notice of Allowability

## Application No.

09/891,985

## Examiner

Susan W Berman

## Applicant(s)

PAUL, CHARLES W.

## Art Unit

1711

### -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Amendment filed 04-05-2004.
2. ☒ The allowed claim(s) is/are 1,2 and 4-16.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 04/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

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***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04-05-2004 has been entered.

***Reasons for Allowance***

The following is an examiner's statement of reasons for allowance:

The rejection under 35 USC 112, second paragraph, is withdrawn in response to applicant's submission of evidence to clarify that the recitation "rosin derived alcohol" defines an alcohol derived from rosin. Applicant has provided a description on page 563 of Handbook of Adhesives, third Edition, Irving Skeist, Editor, of hydroabietyl alcohol being derived from wood rosin that is persuasive support for applicant's argument that the claim language "rosin derived alcohol" is intended to set forth an alcohol derived from rosin. Applicant has also provided trade literature to show that Abitol™ E is hydroabietyl alcohol, a primary, monohydric alcohol derived from hydrogenated rosin acids. However, the trade literature from Hercules is undated so it is not known whether the trademarked material was the same at the time of the invention described in the instant application. The trademark information from the internet site "Storefronts @ SpecialChem" is dated 2004, so it is not persuasive of the description of the material at the time of the instant invention.

Claim 1 has been amended to delete "a saturated block copolymer and/or" and now requires that the adhesive composition comprises a rosin derived alcohol. In response, the rejections based on interpreting "rosin derived alcohol" to encompass a derivative ester of rosin obtained by reacting rosin with an alcohol are hereby withdrawn. WO 01/29134 discloses adhesive compositions comprising an

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epoxidized block copolymer, a diene-mono-ol polymer, a hydrogenated block copolymer of a vinyl aromatic hydrocarbon and a diene with a tackifying resin and a photoinitiator. Erickson (5,382,604 or 5,389,701) discloses compositions comprising an epoxidized diolefin block copolymer, cationic photoinitiators such as triarylsulfonium salts, and adhesion promoting or tackifying resins and compounding oils. The tackifiers taught do not include a rosin derived alcohol.

Dillman et al (5,536,772) teach radiation cured compositions comprising a crosslinked unsaturated epoxidized diene polymer and terpene tackifying resins. Addition of esters of rosins, end block reinforcing resins, such as polystyrene resins, and compounding oils is taught. Dillman et al teach that hydrogenated rosins, esters of rosin and other rosin materials, as taught by Udipi et al (US 4,135,037), are very compatible with epoxidized diene polymers but that they interfere with radiation crosslinking (column 8, line 56, to column 9, line 2) . The rosins disclosed by Udipi et al include modified rosins with alcohols and polyols (column 2, lines 60-67). However, it is agreed, as argued by applicant, rosin materials disclosed by Udipi et al should not be used in radiation curable compositions.

The rejections based on applicant's disclosure on page 5 of the specification that suitable rosin derived alcohols include hydrogenated rosin are hereby withdrawn on the basis that applicant's disclosure is that hydrogenated rosin is used to derive a rosin derived alcohol.

Compositions comprising each of the components set forth in claim 7 in the recited weight percents are not suggested by the prior art cited herein.

The following references are cited as art of interest. Hu et al (6,649,259) disclose radiation curable adhesives comprising an epoxidized block copolymer, a photoinitiator and a tackifier, such as rosin or rosin esters. Schlademan (4,656,213) discloses acrylic hot melt pressure sensitive adhesive compounds comprising tackifiers that are rosin derivatives such as hydroabietyl alcohol. Ansell (5,183,664) disclose adhesive dressings comprising a polyurethane that can have acrylate functional groups. The polyurethane prepolymer is reacted with hydroxyl-containing compounds such as

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hydroabietyl alcohol. a mono-ol with tackifying properties. WO 97/06836 also teaches adhesives comprising a polyurethane having free isocyanate groups reacted with hydroxyl-containing compounds such as hydroabietyl alcohol. a mono-ol with tackifying properties

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Susan W Berman  
Primary Examiner  
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